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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,012	02/26/2002	Eric Thomas Eaton	PT03100UP01D03	6985

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MOTOROLA, INC
INTELLECTUAL PROPERTY SECTION
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EXAMINER
NGUYEN, SIMON

ART UNIT	PAPER NUMBER
2618	

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)
Office Action Summary		10/083,012	EATON ET AL.
		Examiner	Art Unit	
		SIMON D. NGUYEN	2618	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 February 2002</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-5</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-5</u> is/are rejected.
7)☒ Claim(s) <u>4 and 5</u> is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on <u>26 February 2002</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

Claim Objections

1.   Claims 4-5 are objected to because of the following informalities: "**the** location

table output" does not disclose in claim 1. Therefore, claims 4-5 can't depend on claim

1. Furthermore, the word "identifier" is missed spelling (claim 5).

       Appropriate correction is required.

Double Patenting

2.   The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees.   A nonstatutory
obviousness-type double patenting rejection is appropriate where the conflicting claims
are not identical, but at least one examined application claim is not patentably distinct
from the reference claim(s) because the examined application claim is either anticipated
by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140
F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29
USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.
1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422
F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163
USPQ 644 (CCPA 1969).
       A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d)
may be used to overcome an actual or provisional rejection based on a nonstatutory
double patenting ground provided the conflicting application or patent either is shown to
be commonly owned with this application, or claims an invention made as a result of
activities undertaken within the scope of a joint research agreement.
       Effective January 1, 1994, a registered attorney or agent of record may sign a
terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with
37 CFR 3.73(b).

3.   Claims 1-5 are rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claims 15-18 of U.S. Patent No. 6,577,849.

Although the conflicting claims are not identical, they are not patentably distinct from

each other because the claims in the application are broader than the claims in the

patent. In particular, the independent claim in the application omits the step of

transmitting the information address in a first SRW signal responsive to the request.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Yavitz (US 2003/0033385 A1).

        Regarding claim 1, Yavitz discloses a computer/TV set (figs.1, 6), comprising: a

receiver that receives a television broadcast that includes a prompt (paragraph 21); a

prompt mode function (data trigger 37) that provides the prompt on the a display,

wherein the prompt indicating how additional information about the broadcast can be

obtained (paragraphs 21, 48-49), wherein the prompt also indicating the presence of an

information address (the data trigger also contains address/file/desired information

(paragraphs 50). However, Yavitz does not specifically disclose the data trigger having

a state of enabling or disabling the prompt.

        It should be noted that since Yavitz discloses the data trigger having a signal to

command for displaying the prompt, it is obvious that the trigger can either disable or

enable the prompt, which is known to those skilled in the art to allow user to

disable/enable the prompt in order to improve the system performance.

Regarding claim 2, Yavitz further discloses the data trigger signal

transmitting/receiving via a Bluetooth, which is a short-range wireless signal;

determined by a command (clicking the prompt) (paragraphs 36-37).

Regarding claim 3, Yavitz further discloses the data trigger of the prompt is

determined by a location table output (memory location M at specific locations) (figs. 7-

8, paragraph 42).

Regarding claim 4, Yavitz further discloses wherein the location table output

determined by a GPS (paragraphs 42, 44).

Regarding claim 5, Yavitz further discloses wherein the location table output

determined by a local channel identifier (figs. 7-8, paragraph 50).

Conclusion

6.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. Kunkel et al. (US 2002/0056093 A1) discloses a TV set,

displaying a prompt to viewers indicating that an additional information is available on

the program, wherein the prompt embedded with a code and the viewer presses a

specified key on a remote control to obtain the additional information (paragraphs 21-

23, fig.1).

7.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon Nguyen whose telephone number is (571) 272-7894. The examiner can normally be reached on Monday-Friday from 7:00 AM to 4:00PM.

         If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward F. Urban, can be reached on (571) 272-7899.

         Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 306-0377.

         Any response to this action should be mailed to:

                  Commissioner of Patents and Trademarks

                  600 Dulany, Alexandria, VA 22314
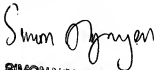
         Or faxed to:

                  (571) 273-8300 (for formal communications intended for entry)

         Hand-delivered response should be brought to Customer Service Window located at the Randolph Building, 401 Dulany, Alexandria, VA, 22314.

         Simon Nguyen

         March 30, 2003

         Simon Nguyen

         SIMON NGUYEN
         PRIMARY EXAMINER